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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,365	12/04/2003	John E. Burton	053990-0039	6378
20572	7590	10/11/2006	EXAMINER	
GODFREY & KAHN S.C. 780 NORTH WATER STREET MILWAUKEE, WI 53202			CARIASO, ALAN B	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/728,365

Applicant(s)

BURTON, JOHN E.

Examiner

Alan Cariaso

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 25-31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-24 is/are allowed.
- 6) ☒ Claim(s) 1-3, 12-14 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 4-10, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Receipt of applicant's amendment filed 17 July 2006 is acknowledged. Claims 1-31 are pending. Claims 1, 13, 18 and 22 are amended. Claims 11 and 25-31 are withdrawn from consideration.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 2 recites "the mounting bracket has *at least one arm extending therefrom* into which the reflector may be snap-fitted", which is indefinite in regards to the *at least one arm* being the same as or different from the claimed "stationary arms extending forwardly therefrom" in preceding claim 1.

5. Claim 12 recites "the mounting bracket has *a plurality of arms*" which is indefinite in regards to the *plurality of arms* as being the same as or different from the claimed "stationary arms extending forwardly therefrom" in preceding claim 1.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 13, 17 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 11/212,070. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 6 of application '070 meets the claimed mounting bracket including arms extending therefrom, the arms dimensioned to pivotally receive a reflector (claim 6 recites the lamp which includes a reflector) and an adjuster secured to the mounting bracket and communicates with the reflector such that rotation of an aiming screw within the adjuster causes pivoting of the reflector (claim 6 recites the adjuster connecting between the mounting bracket and the lamp which includes the reflector, such that rotation of an aiming screw forming part of the adjuster causes pivoting of the lamp which includes the reflector within the arms of

Art Unit: 2875

the mounting bracket) in present claim 1, where the arms being “stationary” and extending “forwardly” therefrom would be obvious since the reflector or lamp received pivotally to the bracket as a stable support and “forwardly” is arbitrary and generally true given no relative reference to the forward direction. Claim 6 of application '070 meets the claimed lamp assembly of present claim 13, as it met the mounting bracket similarly claimed in present claim 1 above, but does not claim the lamp having bulb, which is obvious for any lamp to emit light must at least have a light source which is commonly known in the art to include a bulb. And regarding present claims 2 and 17 which recite “the mounting bracket has at least one arm extending therefrom into which the reflector may be snap-fitted” and “the reflector snap fits into the mounting bracket”, respectively, claim 6 of application '070 meets these limitations with “the adjuster is snap-fitted into the lamp” (the lamp includes the reflector) as being obvious because the lamp with reflector is pivotally received by the claimed stationary arms of the mounting bracket, and because the reflector snap fits into the mounting bracket, by deduction it is obvious that the reflector snap fits onto the stationary arms or at least one arm of the mounting bracket where the reflector is received, and vice-versa, where the arms of the mounting bracket or the mounting bracket itself into which the reflector is snap-fitted. Present claim 18 claims a method of assembling an adjuster and bracket assembly, whereby, claim 6 of application '070 includes the claimed essential structure or parts which inherently meets the steps of securing the adjuster to the mounting bracket, pivotally attaching a reflector and engaging the adjuster to the reflector.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, 12-14 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over CAMINETTI, JR (US 1,712,690).

10. CAMINETTI discloses an adjuster and bracket assembly comprising: a mounting bracket (yoke 28, flange 32, ring 31 in fig.2), having stationary arms (29) extending forwardly therefrom, the stationary arms (29) dimensioned to pivotally (figs.5-6) receive a spotlight (30); an adjuster (72,73,39,42,43) secured to the mounting bracket (28,31,32 fig. 2) such that when the spotlight (30) is pivotally received by the stationary arms (29) of the mounting bracket (28) after the adjuster (72) has been secured thereto, the adjuster (72,73,39,42,43) communicates with the spotlight such that rotation of an aiming screw (72,73) within the adjuster (72,73,39,42,43) causes pivoting of the spotlight (30) within the stationary arms (29) of the mounting bracket (28,31,32); wherein the mounting bracket (28,31,32) has a head retaining bracket (21), the aiming screw (72,73) of the adjuster fitted into the head retaining bracket (21); wherein the mounting bracket (28,31,32) has a plurality of arms (29) and the spotlight has a plurality

of posts (68), the arms (29) functionally engaging the posts (28) such that actuation of the adjuster causes the reflector to pivot on the posts; a lamp assembly installed into a vehicle (4, fig.1)

11. However, CAMINETTI does not disclose a reflector, lens and bulb. HUNT teaches a vehicle spotlight comprising a reflector (12), lens (fig.6) and bulb (14) for the purpose of providing an optically enhanced spot beam light forward the vehicle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the adjustable lamp and mounting bracket assembly of CAMINETTI JR to include the type of reflector, lens and bulb as taught by HUNT in order to project a spot light beam enhance by reflective and refractive optics forward of the vehicle.

***Allowable Subject Matter***

12. Claims 4-10, 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 22-24 are allowed.

***Response to Arguments***

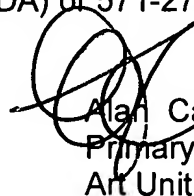
14. Applicant's arguments with respect to claims 1-10 and 12-21 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Alan Cariaso  
Primary Examiner  
Art Unit 2875

October 2, 2006  
AC